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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,674	07/13/2001	Christoph Reinhard	PP-01700.002 / 200130.521	4819
7590 03/31/2004			EXAMINER	
Chiron Corporation Intellectual Property R338 P.O. Box 8097 Emeryville, CA 94662-8097			LACOURCIERE, KAREN A	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

84.

Advisory Action	Application No. 09/905,674	Applicant(s) REINHARD ET AL.	
	Examiner Karen A. Lacourciere	Art Unit 1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 24 and 35.

Claim(s) objected to: _____.

Claim(s) rejected: 23, 25-34 and 36-38.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The proposed amendments for claim 23 adds a polynucleotide 90% identical to the previously recited polynucleotides and adds functional language. The previously presented claim included this limitation as a separate sentence, not part of the claim, and therefore, requires a new search and further considerations. The proposed amendments to claim 25 adds functional language to the claims and would require further considerations and further search.

Continuation of 3. Applicant's reply has overcome the following rejection(s): Applicant's proposed amendments, if entered, would overcome the rejection of claims 23 and 34 under 35 USC 112, second paragraph, however, the amendments have not been entered.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that the Declaration filed 03-22-2004 overcomes the rejection of record under 35 USC 112, first paragraph, however, the declaration is not directed to issues newly raised in the final rejection and there is no reason it was not earlier presented and, therefore, it has not been considered. Applicant argues that the references cited to support the unpredictable nature of function prediction for proteins based on sequence homology are off point because they are not directed to Tetraspan proteins, as claimed. This is not persuasive, because the references taken together support that the prior art in the field of protein chemistry supports that functional predictions are not predictable based on the sequence alone. Applicant argues that the reference Attwood et al., applied in the rejection of record, supports Applicant's position that SEQ ID NO:2 is a tetraspan protein, because Applicant has pointed to patterns of conserved motifs, as Attwood suggests motifs can begin to provide structural clues. This is not persuasive because the description of the structural motifs relied upon by Applicant for SEQ ID NO:2 have been so vaguely described it is unclear that SEQ ID NO:2 even possesses those motifs (as discussed in the rejection of record). Applicant argues that Applicant is entitled to an affidavit according to In re Sun regarding the grounds of rejection under 35 USC first paragraph, however, Applicant has not provided any suggestion that the facts of In re Sun have any similarity to this case or that the holding of In re Sun is at all applicable in the instant case. Applicant points to 37 CFR 1.104 as providing for a requirement for an affidavit, but the only section of 37 CFR 1.104 providing for affidavits from an Examiner is in section (d)(2), which addresses the situation wherein the Examiner relies upon facts within the personal knowledge of an employee of the Office, which is not the case in the rejection of record under 35 USC 112 first paragraph of record and 37 CFR 1.104(d)(2) is not applicable in this case. Applicant argues that the characteristics of tetraspan proteins, discussed in Serru, are not contradictory with the results of the disclosure of the Application, because Serru only assesses the properties of 3 out of 7 tetraspan proteins and demonstrate that their properties are the opposite to those disclosed for SEQ ID NO:2, but have not characterized 4 other tetraspan proteins with regard to the correlation of expression with metastatic potential. Applicant argues that Serru does not conclude that a characteristic of tetraspan proteins is that expression correlates inversely with metastatic potential (the opposite of that observed for SEQ ID NO:2). This is not persuasive because Serru supports that SEQ ID NO:2 does not seem to exhibit the same activities as observed for other members of the tetraspan protein group, as observed by Serru, whether or not these characteristics have been generally characterized for all tetraspan proteins. Applicant argues that the amendments to the claims overcome the rejection of record under 102(a), however, these amendments have not been entered and further, it is unclear how the amendments distinguish the claimed polynucleotide from that disclosed by Ruben et al. The polynucleotide disclosed by Ruben et al. appears to still meet all of the physical limitations of claims 23, 25-34, 37 and 38. Applicant argues that claims 37 and 38 do not include open language, however, "having" is open language, as recited in claims 37 and 38 and, therefore, are drawn to nucleic acids encoding a polypeptide comprising SEQ ID NO:13 or 14, as discussed in the rejection of record.



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PRIMARY EXAMINER